

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of
Cecile Combeau et al.

Examiner: Waller, Robin Regina

Art Unit: 1626

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Application No.: 10/659,094

Filed: **September 10, 2003**

TELEFAX CERTIFICATE

AUG 31 2004

Title: **Compounds Derived From Oxindoles
and Their Therapeutic Application in
Cancer Treatment**

I hereby certify that this correspondence is being
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**ELECTION OF INVENTION AND REQUEST FOR
RECONSIDERATION AND WITHDRAWAL OF RESTRICTION
REQUIREMENT UNDER 37 C.F.R. 1.143**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a response to the outstanding Office Action, dated August 11, 2004, for which a response is due by September 11, 2004. Entry of the following election with traversal is respectfully requested.

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Election of Invention

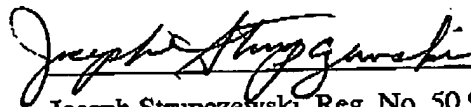
The Examiner has imposed a three-way restriction requirement for the instant application, asserting that claims 1-5, designated Group I, drawn to a compound and compositions comprising the compound describe one invention, whereas claims 6-9 designated Group II, drawn to a process of making describe another, and Group III claims 11-15 drawn to method of treatment of primary tumors of cancer. The Examiner has further indicated that claims 6-9 drawn to a process of making can be rejoined if claims of Group I are found allowable. Applicants disagree, but nonetheless provisionally elect Group I invention claims 1-5, for initial prosecution with traverse.

Traverse of Restriction Requirement

For the record, Applicants disagree with the Examiner's statement that Mr. Strupczewski did not respond to the Examiner's request for an oral election. Mr. Strupczewski spoke with the Examiner on June 23, 2004 and provisionally elected claims of Group I. for initial prosecution. Nonetheless, concerning the restriction requirement, the Examiner has cited MPEP 821.04 to justify the rejoinder of process claims if the product claims are found allowable. We bring to the Examiner's attention that within the same section of the MPEP is found wording that specifically states that method of use claims should also be rejoined. Thus, as found in MPEP 821.04: "Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims of making and/or using by way of amendment pursuant to 37 CFR 1.121 (emphasis added)."

Therefore, in view of the above Applicants respectfully request that the Examiner also rejoin claims 11-15 of Group III, if the claims of Group I are found allowable.

Respectfully submitted,



Joseph Strupczewski, Reg. No. 50,903

Attorney/Agent for Applicant

Aventis Pharmaceuticals Inc.
Patent Department
Route #202-206 / P.O. Box 6800
Bridgewater, NJ 08807-0800
Telephone (908) 231-2387
Telefax (908) 231-2626
Docket No. USST01010 US CNT

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